

Remarks

In the Office Action dated February 7, 2008, the Office alleged that the amendment and response that was filed on October 17, 2007 was not fully responsive to the Office Action dated July 27, 2007. In particular, the Office stated that Applicant's response was not fully responsive because it merely pointed out specific limitations of the amended claims that were neither taught nor suggested by the combined art of record. While Applicant believes that the failure of the prior art (or any knowledge subject to Official Notice properly taken by the Office) to teach or suggest any explicitly relied upon limitations of an independent claim will, alone, prevent the Office from being able to properly sustain an obviousness rejection, Applicant will nevertheless elaborate on Applicant's position on non-obviousness as set forth in greater detail below.

The Office also suggested that the amendment and response that was filed on October 17, 2007 was not fully responsive to the Office Action dated July 27, 2007 because it failed to show where support can be found for the newly added claim limitations. While Applicant respectfully submits that an Applicant is not *per se* required to specifically point out support for every claim amendment made every time an Applicant files a amendment unless support is specifically challenged by the Office, Applicant will nevertheless outline the support for the amendments in greater detail below.

§103 Rejections

Claims 1, 3-5, 7-9, 11, and 12 were rejected under 35 U.S.C. §103(a) as being obvious over Clarey (U.S. Pat. No. 4,157,713). Claims 1 and 8-11 were rejected under 35 U.S.C. §103(a) as being obvious over Birk (U.S. Pub. No. 2005/0192531). Under MPEP 2143.03, in order to establish a *prima facie* case of obviousness, the Office must give due consideration to all of the limitations of a claim. The Office must also sufficiently establish a motivation to combine or modify the teachings of the prior art in order to reach a claimed invention in accordance with MPEP 2143.01. Obviousness rejections "cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness." *KSR International Co. v. Teleflex Inc.*, 82 USPQ2d 1385, 1395-97 (2007) (quoting *In re Kahn*, 441 F.3d 977, 988 (Fed. Cir. 2006)). For at least the reasons set forth below, Applicant respectfully submits that the

combined art of record fails to render any of the present claims obvious, and that the Office Action dated July 27, 2007 is therefore distinctly defective.

Applicant submits that the Office Action dated July 27, 2007 fails to sufficiently consider all of the limitations recited in each amended independent claim in accordance with MPEP 2143.03. Indeed, some of the amended limitations were not even present in the claims as of July 27, 2007, such that the July 27, 2007 Office Action is essentially rendered moot by the amendments that were made on October 17, 2007. For instance, Applicant notes that amended independent claim 1 recites a “balloon that includes a wall having an exterior surface, wherein the exterior surface of the balloon wall is secured adjacent to and against the outer surface of the belt along a length of the balloon wall, wherein said balloon comprises a plurality of partitions provided by partition walls extending substantially perpendicularly from and connecting opposing interior sides of the balloon wall, wherein the plurality of partition walls define a plurality of inner chambers, wherein the plurality of inner chambers are immediately adjacent to one another, wherein the exterior surface of the balloon wall extends along the plurality of inner chambers.” These limitations, among others recited in amended claim 1, are neither taught nor suggested by the combined art of record. Incidentally, the Office Action dated July 27, 2007 also fails to sufficiently consider these limitations in accordance with MPEP 2143.03. An obviousness rejection therefore could not be sustained based on the prior art and rationales relied upon in the Office Action dated July 27, 2007.

Thus, the Office Action dated July 27, 2007 contains the *distinct and specific error of failing to explicitly state how and where the above-quoted limitations are taught or suggested by the combined art of record; or how or why one of ordinary skill in the art would have been motivated to modify the teachings of the prior art to reach such a combination of limitations*. This is thus a distinct and specific shortcoming of the Office Action dated July 27, 2007. Accordingly, Applicant respectfully maintains that the combined art of record fails to render present claim 1 obvious in accordance with MPEP 2143, and respectfully requests that the rejection be withdrawn. Applicant further respectfully submits that Applicant has pointed out errors in the Office Action dated July 27, 2007 with sufficient distinctness and specificity to satisfy any requirements imposed by 37 CFR §1.111(b).

To the extent that the Office objects to the Applicant's reliance on such a relatively large quoted portion of the claim language of claim 1, Applicant notes that Applicant is

relying on the combination and arrangement of features recited in the quoted portion of the claim language. In other words, applicant is not relying on a particular limitation in claim 1 in isolation to overcome the prior art, but rather the combination and arrangement of limitations as quoted above. To the extent that the Office maintains that such a reliance is objectionable, the Office is respectfully requested to specifically cite a provision of law or regulation that prohibits such reliance by an Applicant. Ultimately, Applicant maintains that the combined art of record fails to teach or suggest the above-quoted combination of limitations, and that the Office has failed to provide sufficient evidence or a sufficient rationale as to why someone of ordinary skill in the art would have been motivated to modify the prior art teachings to obtain the presently claimed combination, such that the obviousness rejection cannot be sustained based on the present combination of prior art and rationale relied upon by the Office.

Applicant further notes that the dependent claims include additional limitations not taught or suggested in the art of record, thus forming independent basis for non-obviousness. In other words, the dependent claims are non-obvious for at least the same reasons noted above with respect to amended independent claim 1. Applicant respectfully submits that the Applicant does not need to address the patentability of the dependent claims in any greater detail at this time, given that distinct and specific reasons have already been given as to why claim 1 (from which every dependent claim depends) is patentable over the combined art of record.

Furthermore, Applicant notes that the Office bears the burden to establish a *prima facie* case of obviousness. See MPEP 2142. This means that an Applicant is not required to produce evidence of non-obviousness unless and until the Office has met its burden to establish a *prima facie* case. See MPEP 2142. Indeed, this principle is inherent in the concept of a “*prima facie* case.” See MPEP 2142. Since the Office has failed to establish a *prima facie* case, Applicant is not required to produce evidence to rebut such a non-existent *prima facie* case. In other words, the Office cannot fault Applicant for failing to provide evidence unless and until the Office has met its burden to establish a *prima facie* case of obviousness, which the Office has so far failed to do as noted above. The Office’s admonition that “arguments or conclusions of the attorney cannot take the place of evidence” is therefore premature, as no evidence is yet required of Applicant. See MPEP 2142.

Support for Amended Claim Language

As an initial matter, Applicant notes that “there is no *in haec verba* requirement” under 35 U.S.C. §112 in order for an original disclosure to provide adequate support for language in a claim. See MPEP 2163. In other words, an Applicant need not provide citations to identical language in the specification to establish support for language in an amended claim. Indeed, an Applicant need only provide a patent specification and drawings that describe the claimed invention in sufficient detail that one skilled in the art can reasonably conclude that the inventor had possession of the claimed invention.

Applicant respectfully submits that Figure 4 and its accompanying text from the present application provides much support for the amended claim language of claim 1. In particular, Figure 4 clearly shows a tension carrying belt (22) having an outer surface, such as is recited in amended claim 1.

Figure 4 also clearly shows a balloon (28) that is attached to a tension carrying belt (22), such as is recited in amended claim 1. Paragraph [0019] of the original specification further explicitly describes a balloon “affixed” to a tension carrying belt.

The balloon (20) shown in Figure 4 clearly has a wall with an exterior surface, as one of ordinary skill in the art would naturally expect a balloon to have, such as is recited in amended claim 1.

Figure 4 also clearly shows the exterior surface of a balloon (20) wall secured adjacent to and against the outer surface of a belt (22) along a length of the balloon (20) wall, such as is recited in amended claim 1.

Figure 4 also clearly shows a plurality of partitions provided by partition walls (30) that extend perpendicularly from and connect opposing interior sides of a balloon (20) wall, such as is recited in amended claim 1. Examples of such partitions are further described in paragraph [0022] of the original specification.

Figure 4 also clearly shows how a plurality of partition walls (30) define a plurality of inner chambers (32) that are immediately adjacent to one another, such as is recited in amended claim 1. Again, examples of such partitions are further described in paragraph [0022] of the original specification.

Figure 4 also clearly shows how the exterior surface of a balloon (20) wall extends along a plurality of inner chambers (32), such as is recited in amended claim 1.

Figure 4 also clearly shows a fluid supply tube (24) that is attached to the outer surface of a tension carrying belt (22), such as is recited in amended claim 1. An example of a fluid supply tube is further described in paragraph [0023] of the original specification. Attachment of a fluid supply tube to a belt is further described in paragraph [0024] of the original specification.

Figure 4 also clearly shows a fluid supply tube (24) that has a plurality of inlets (34) that provide fluid communication between a corresponding one of a plurality of inner chambers (32) and a fluid supply tube (24), such as is recited in amended claim 1. Examples of such inlets and fluid communication are further described in paragraph [0023] of the original specification.

Figures 3 and 4 both clearly show at least a portion of a fluid supply tube (24) passing through the partition walls (30), such as is recited in amended claim 1. Note the broken lines of the partition walls (30) in the region of fluid supply tube (24) shown in Figure 4.

Paragraph [0027] of the original specification clearly and explicitly teaches inserting a segmented gastric band through a trocar, such as is recited in amended claim 1. Paragraph [0027] of the original specification also clearly and explicitly teaches fitting a segmented gastric band around a portion of a patient's stomach (in particular, "near the esophagogastric junction"), such as is recited in amended claim 1.

The above-cited portions of the original specification and drawings are being relied upon merely as teaching examples of embodiments that provide adequate support for the language of amended claim 1. Applicant does not intend to be necessarily limited in claim construction to the specific embodiments shown in the drawings or described in the specification. Indeed, Applicant intends that the claims be construed as broadly as permitted under the law. No disclaimer is made or intended; and Applicant has no intention of creating any estoppel with the arguments made herein.

In view of the foregoing, Applicant maintains that the present claims find adequate support in the original specification and drawings. To the extent that the Office disagrees, the Office is respectfully requested to cite specific claim language that the Office believes does

not find adequate support in the original disclosure, so that Applicant will have a full and fair opportunity to respond.

Conclusion

While several distinctions have been noted over the art of record, Applicant notes that there are several other limitations recited in the present claims which are neither taught nor suggested by the art of record. Applicant expressly reserves all rights and arguments with respect to distinctions not explicitly noted herein. In addition, to the extent that the amendments constitute a narrowing of the claims, such narrowing of the claims should not be construed as an admission as to the merits of the prior rejections. Indeed, Applicant traverses the rejections and preserves all rights and arguments. To the extent that any particular statement or argument by the Office in the pending Office Action has not been explicitly addressed herein, the same should not be construed as an acquiescence or admission by the Applicant that such statements or arguments by the Office are accurate or proper.

Based on the foregoing, all pending claims are in a condition for allowance. Accordingly, Applicant respectfully requests reconsideration and an early notice of allowance. Should the Examiner wish to discuss the amendments or arguments made herein, Applicant invites the Examiner to contact the undersigned at (513)369-4811 or via e-mail at [aulmer@fbtlaw.com](mailto:aulmer@fbtlaw.com).

The Commissioner for Patents is hereby authorized to charge any deficiency or credit any overpayment of fees to Frost Brown Todd LLC Deposit Account No. 06-2226.

Respectfully Submitted,



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